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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/072,599	02/05/2002	Robert H. Dahl	CB-11	2789
21394	7590	09/28/2005	EXAMINER	
ARTHROCARE CORPORATION 680 VAQUEROS AVENUE SUNNYVALE, CA 94085-3523				HAYES, MICHAEL J
		ART UNIT		PAPER NUMBER
		3763		

DATE MAILED: 09/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/072,599	DAHLA ET AL.
	Examiner Michael J. Hayes	Art Unit 3763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 06 September 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-11,13-22 and 25-84 is/are pending in the application.
- 4a) Of the above claim(s) 13,15-22,28-36 and 38-82 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-11,14,25,27,37,83 and 84 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 05 February 2002 is/are: a) accepted or b) objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date 9/22/05
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/6/05 has been entered.

### *Election/Restrictions*

Applicant's election without traverse of group I and species 10 drawn to fig. 16B in the reply filed on 10/22/04 is acknowledged.

Claims 13, 15-22, 28-36, and 38-82 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention and/or species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 10/22/04.

This application contains claims 13, 15-22, 28-36, 38-82 drawn to an invention nonelected with traverse in Paper received 10/22/04. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

### *Drawings*

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the spacer around the return electrode

as recited in claim 1 and the return electrode coil wound in proximal direction away from the shaft distal end as recited in claim 8 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 and 8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The amendments that the spacer is disposed around the return electrode (claim 1) and the return electrode wound in a proximal direction away from the shaft distal end (claim 8) are not supported in the application as filed.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim is indefinite because it recites a broad range and a narrow range in the same claim and the scope of the claim cannot be determined. See MPEP 2173.05(c)(d).

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 3, 6, 8, 27, 83, and 84 are rejected under 35 U.S.C. 102(b) as being anticipated by RYDELL (US Patent No. 5,047,027). Rydell discloses an electrosurgical probe

including a return electrode coil 28, and active electrode 30 within a lumen of the return coil. The return electrode coil has more than 6 turns, is parallel to the longitudinal axis of return electrode filament, the first turn is at the distal end (whether the first turn is considered at the distal or proximal end is merely a matter of whether counting starts at the distal or proximal end), and an insulating spacer 46 is proximal to the electrode head (See figs. 1, 2; col. 3, ll. 1-45). The spacer is surrounded by the return electrode. The active electrode head is seen as the tip of the active electrode filament and is configured as a flattened disc or plane perpendicular to the coil axis.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, 5, 9, 10, 11, 14, 25, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over RYDELL in view of GOBLE (US Patent No. 5,891,134) and/or RYAN (US Patent No. 6,280,441). Rydell discloses the claimed invention as discussed above except for the helix pitch of 0.01-0.045in., electrode coil external diameter 0.07-0.2 in., return electrode filament diameter 0.008-0.03 in., active electrode filament diameter 0.006-0.02 in., ceramic insulating spacer, and handle housing the connection block. Goble teaches the use of a ceramic insulating spacer and handle housing the connection block. It would have been obvious to one of ordinary skill in the art at the time of the invention to use the teachings of Goble in the probe of

Rydell in order to use a well-known material for insulation and to obtain an efficient device that is easy to use by having the handle house the connection. With respect to claims 4, 5, 9, 14 it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the probe disclosed by Rydell to the claimed dimensions because Applicant has not stated that these dimensions are for a stated purpose or to solve a particular problem and it appears other dimensions would work equally as well. Applicant has not supplied any criticality with respect to these dimensions and they are merely design choice. With respect to claim 10 Ryan teaches the use of gaps between turns. The spacing of the gaps is capable of retaining liquid against coil surfaces. It would have been obvious to one of ordinary skill in the art at the time of the invention to use the teachings of Ryan in the invention of Rydell to obtain spaced coils that can be easily attached to tissue.

Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over RYDELL in view of COHEN (US Patent No. 4,832,048). Rydell discloses the claimed invention except for making the electrodes of titanium. Cohen teaches to use these materials for insulation and for the electrodes. It would have been obvious to one of ordinary skill in the art at the time of the invention to use the teachings of Cohen in the probe of Rydell in order to make an electrosurgical probe using common, well-known materials for insulation and electrodes.

***Allowable Subject Matter***

Claim 7 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Hayes at (571) 272-4959. The examiner can usually be reached Monday -Thursday, 7:00-4:30, and on alternate Fridays. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nick Lucchesi, can be contacted at (571) 272-4977. The fax number for submitting official papers is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mjh  
22 September 2005



**MICHAEL J. HAYES**  
**PRIMARY EXAMINER**